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BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP  
Seventh Floor  
12400 Wilshire Boulevard  
Los Angeles, CA 90025-1026

EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/020,487

Applicant(s)

KWOK ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-5 and 9-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-5, 9-21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment received on 9/26/2005 is acknowledged and entered. Claims 6-8 are canceled and claims 1 and 20 are amended. Currently claims 1-5, 9-21 are pending for examination.

### ***Response to Arguments***

2. Applicant's arguments filed on 9/26/2005 (see remarks pages 6-8) concerning claim 1 have been fully considered but they are not persuasive. The applicant argues that the cited reference Starr does not teach the added limitation, "the system administration module defining at least three levels of access security including a first level enabling....., a second access level enabling....., a third level of access security enabling....completion of at least one transaction". The examiner respectfully disagrees. Starr does teach defining three or more different levels of access to a server database (see at least col.7, lines 5-67) based upon different criteria related to the subscriber. Starr further states that the techniques/principles of restricting accesses based upon certain criteria related to the subscribers to certain information/database files by configuring the operating system are well-known in the art ( see col.8, lines 1-13, " *The design and development of the access controller follows from principles known in the art of computer programming, including those set forth in Wall et al., Programming Perl, O'Reilly & Associates (1996); and Johnson et al, Linux Application Development, Addison-Wesley (1998). Additionally, in other embodiments, the access controller 42 can be implemented, at least in part, by employing the operating system to restrict the execution of certain scripts and to restrict access to certain files by configuring the operating system in a selected manner. Techniques for so configuring the operating system are known in*

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*the art, including those techniques set forth in Bach, The Design of the Unix Operating System, Prentice-Hall (1986).* ").

Starr does not disclose the intended functions of the three different levels as recited in the claim but since the invention is directed to an apparatus/system the analysis to distinguish them from the prior art should be on the basis structural elements rather than intended function. See MPEP 2114 :Apparatus and Article Claims - Functional Language [R-1] . APPARATUS CLAIMS MUST BE STRUCTU-RALLY DISTINGUISHABLE FROM THE PRIOR ART >While features of an apparatus may be recited either structurally or functionally, claims<directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (**The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference**); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art

apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer.

In view of the above referred teachings of Starr and MPEP guidelines, it would be obvious to one of an ordinary skilled in the art to design several access limits based upon different criteria and intended functions including the one recited in claim 1. Therefore, the examiner maintains rejection of claim 1 as being unpatentable over Starr and for the same reasons rejections of all claims is sustainable based upon new grounds of rejection necessitated due to current amendments.

This is a Final rejection.

3. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the

references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claims 1-2, 4-5, 9-12, 14 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starr (US Patent 6,606,606).

Regarding claim 1, Starr discloses a system for managing oil and gas industry data and granting a user access to the data over a network (see at least Figs. 1 and 2. Note: the recitation "*for managing oil and gas industry data*" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the recitation, "*for managing oil and gas industry data*" is the intended use of a

structure and the body of the claim that follows, after comprising, that is " *a database within.....system administration module*" does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone. ) comprising:

a database within at least one server operatively connected to the network, the database containing data from at least one customer ( see at least reference "16" in Fig.1 and col.4, lines 7-25. Note: Database "16" is within at least one server "14" operatively connected via network "20" and the database contains data from the service providers "18" which are customers. See also, col.5, line 58-col.6, line 11.) ;

a system administration module for granting the user access rights to a customer's industry data, wherein the user can access a customer's industry data across the network upon being granted access rights by the system administration module (see at least col.4, lines 14-25, " *The elements of the system 10 can include commercially available systems that have been arranged and modified to act as a system according to the invention, which allows a subscriber to carry out integrated financial transactions, and optionally generated records of these integrated transactions. The system 10 of FIG. 1 employs the Internet to allow a subscriber at a remote client, the subscriber systems 12, to access a central server, the depicted central server 14, to login to an account maintained by that server, and to employ the services provided to that account to perform financial transactions that are commonly required by a small business.* ". Note: "subscriber" in Starr corresponds to the user who can access the service provider's data (customer's data) across the network, that is Internet. A subscriber is one who is registered and by using the necessary password/pin is granted access to the database).

Starr further discloses defining three or more different levels of access security to a server database (see at least col.7, lines 5-67) based upon different criteria related to

the subscriber. Starr further states that the techniques/principles of restricting accesses based upon certain criteria related to the subscribers to certain information/database files by configuring the operating system are well-known in the art ( see col.8, lines 1-13, “ *The design and development of the access controller follows from principles known in the art of computer programming, including those set forth in Wall et al., Programming Perl, O'Reilly & Associates (1996); and Johnson et al, Linux Application Development, Addison-Wesley (1998). Additionally, in other embodiments, the access controller 42 can be implemented, at least in part, by employing the operating system to restrict the execution of certain scripts and to restrict access to certain files by configuring the operating system in a selected manner. Techniques for so configuring the operating system are known in the art, including those techniques set forth in Bach, The Design of the Unix Operating System, Prentice-Hall (1986).* ”).

Starr does not disclose the intended functions of the three different levels as recited in the claim, that is a first level with the intended use of enabling public access to public industry data without system registration, a second access level with the intended use of enabling the user access to specific industry data only after system registration and a third level of access with the intended use of enabling the user to access and manipulate a customer's industry data after the customer grants access approval to the user upon completion of at least one transaction. But since the invention is directed to an apparatus/system the analysis to distinguish them from the prior art should be on the basis structural elements rather than intended function. See MPEP 2114 :Apparatus and Article Claims - Functional Language [R-1] . APPARATUS CLAIMS MUST BE STRUCTU-RALLY DISTINGUISHABLE FROM THE PRIOR ART >While features of an apparatus may be recited either structurally or functionally,



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claims<directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (**The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference**); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

"[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer.

In view of the above referred teachings of Starr and MPEP guidelines, it would be obvious to one of an ordinary skilled in the art to design several access limits based upon different criteria and intended functions including the ones recited in Starr and as well as claim 1, such as a first level with the intended use of enabling public access to public industry data without system registration, a second access level with the intended use of enabling the user access to specific industry data only after system registration and a third level of access with the intended use of enabling the user to access and manipulate a customer's industry data after the customer grants access approval to the user upon completion of at least one transaction .

Regarding claim 2, Starr discloses that the system as in claim 1 wherein the system is an internet portal and website, the website including a home page module having operative links to the database and the system administration module (see at least Figs. 1 and 2 and col.4, lines 26-48, "*For example, the server 14 can present the subscriber with an HTML page that acts as a user interface. This user interface can present to the subscriber a set of controls for performing financial transaction typical for a small business. For example, the user interface can provide to the subscriber a control, typically a button on a web page, that directs the system to perform a payroll operation. For this transaction, upon activation of the user control, the server 14 can create instructions that can be followed by the different financial service providers that have a role in the payroll financial transaction. ....*" , Note: An user can access the database and the system administration module via the HTML page in order to carry out use the service provider's services. The server system "14" in Starr represents an internal portal and website.) .

Regarding claim 4, Starr teaches that the system as in claim 1 further comprising a project management module operatively linked to the home page enabling a customer to access project management software to control access by third parties and to monitor third party access to the industry data through the system administration module (see at least col.7, lines 5-20. The access controller "42" using an application program control's and monitors access by the users . The users correspond to third parties and the access controller "42" corresponds to the project management module).

Regarding claim 5, Starr teaches that the system as in claim 1 wherein the wide area network is the Internet or an Internet or a combination thereof (see at least col.4, lines 49-57, " ..a network 20, such as the Internet.... ").

Regarding claims 9 and 11, Starr discloses that the system as in claims 1 and 2 further comprising industry data viewing and processing software operatively connected to the system/home page to enable a user having access rights to view or process or analyze or interpret the industry data/specific software applications from a remote location across the network (see at least col.7, line 5-col.8, line 13. A user is allowed to access industry data related to payrolls and can both view and process the data from a remote location).

Regarding claim 10, Starr discloses that the system as in claim 2 wherein a third party service or product provider web page is operatively linked to the system (see at least Figs. 1 and 2 which disclose that the product provider web pages, see reference "18" are operatively linked to the web server "14").

Regarding claim 12, Starr teaches that the system as in claim 2 wherein the home page module is operatively linked to any one of or a combination of data software modules including data management, data mapping, data processing, and data viewing software, a virtual client room module, a project management module, a resource module, a business floor module and third party modules including any one of or a combination of professional services, technical services and financial services (see at least col.5, line 58-col.6, line 51 and Figs. 1 and 2. Starr discloses that the HTML page of the web server "14" is operatively connected to clients "12, to any number of service providers "18").

Regarding claim 14, Starr discloses that the system as in claim 4 wherein the third parties are financiers (see at least col.6, lines 12-51. Starr discloses that the service provider "18" can be any entity which provides services, such as, credit services. In fact the system architecture of Starr can also be used by any one of geologists, geophysicists, engineers to provide data to web server "14" and then letting users access that data).

Regarding claim 19, Starr discloses that the system as in claim 1 wherein the system administration module acts as an intermediary in a financial transaction between a customer and user (see at least col.7, lines 21-67. Starr discloses that the system administration module in web server "14" acts as an intermediary in a financial transaction, that is implementing payroll function, between a customer [payroll service provider "18" and user (client "12').

Regarding claims 20-21, their limitations are already covered in claims 1-2, 4-12 and 14-19 above and are therefore analyzed and rejected on the same basis.

4.2. Claims 3, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starr in view of the article, , " Multex Launches Research-On-Demand", Information Today; v 15, n4, p 28, April 1998; extracted on Internet from Dialog on Internet on 8/24/2004, hereinafter referred as Multex.

Regarding claim 3, Starr discloses that the system as in claim 2 further comprising a virtual client room module operatively linked to the home page enabling a customer's industry data to be located in a specific location on the website (see at least Fig.1 and 2, col.4, line 49- col.6, line 51 which disclose that client systems 12 are operatively linked to the HTML page of web server "14" and via these client modules it is possible to locate customer's industry data located on specific location on the website at reference "18". Starr does not disclose that this data is graphically stored.

However, in the field of same endeavor, Multex teaches that customer's data, that data from service providers, such as brokerage research reports is stored graphically. In view of Multex, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Starr to incorporate the feature of storing data graphically because it would enable the financial service providers in Starr to store data in form of charts, graphs for presentation to the users.

Regarding claim 13, Starr discloses that in system as in claim 12 the data software modules are remote to the system and a customer or user can access a specific data software module. Starr does not disclose that the access is granted on a pay per use basis. However, in the field of same endeavor, Multex teaches that the access is granted to specific data software module, such as research reports for prices varying from \$4 to \$ 150. In view of Multex, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Starr to suggest that a user can access a specific data software module on a pay per use basis because to complete the transaction by charging the user for the services.

Regarding claim 17, Starr in view of Multex discloses that the system as in claim 3 wherein the system administration module enables multiple parties to access industry data within a virtual client room module simultaneously (see at least Starr col.4, line 58- col.5, line 26. A plurality of client systems 12 can access the web server "14" simultaneously to access industry data).

4.3. Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starr in view of Silverman et al. (US Patent 5,136,501), hereinafter referred to Silverman.

Regarding claim 15, Starr does not suggest that the system administration module does not identify the identity of parties prior to the completion of a transaction. However, in the same field of electronically providing matching transactions in order to complete trades between bids and offers, Silverman suggests not to identify the identity of parties prior to the completion of a transaction (see at least col.3, lines 39-52, col.2, lines 17-63 and col.1, lines 43-47 and lines 56-59). In view of Silverman, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Starr to suggest that the system module does not identify the identity of parties prior to the completion of a transaction, because anonymous matching systems are often desired, as explicitly disclosed in Silverman, see col.1, lines 43-47) to hold the identity of the parties engaging into transactions till they are completed.

Regarding claim 18, its limitations are closely parallel to the limitations of claim 15 and therefore it is analyzed and rejected on the same basis.

4.4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Starr in view of Multex and further in view of Finsterwald (US Patent 6,039,244).

Regarding claim 16, Starr in view of Multex discloses that the system in claim 3 allows virtual clients to be operatively connected to the home page of the system where the customer's industry data is graphically located in specific locations on the website. Starr in view of Multex does not disclose that access to a virtual client room is limited to a specific time by the system administration module. However, in the analogous field of endeavor of giving an user access rights to a chat room online, Finsterwald teaches that access to a virtual client room is limited to a specific time (see at least col.6, lines 32-39). In view of Finsterwald, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Starr to suggest that access to a virtual client room is limited to a specific time because this will allow only those users to access the database who have paid for it for a specific period of time as explicitly disclosed in Finsterwald and so that an overload could be avoided.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the



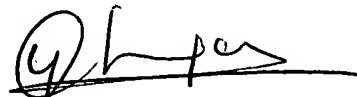
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
December 8, 2005